

The opinion in support of the decision being entered today was not
written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LIGIA DOMINGUEZ DE WALTER,
BANKS B. MOORE and PETER KLEIN

MAILED

Appeal No. 1998-3148
Application 08/520, 662

JAN 15 2002

REMAND TO EXAMINER

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before PAK, OWENS and WALTZ, Administrative Patent Judges.

OWENS, Administrative Patent Judge.

REMAND

This is an appeal from the examiner's refusal to allow claims 1-7, 10-15, 19-26 and 29 as amended after final rejection.¹ Claims 8, 9, 16-18, 27 and 28, which are all of the other claims in the application, stand withdrawn from consideration by the examiner as being directed toward a nonelected invention. Claims 1-7, 10-15, 19-26 and 29 stand

¹ The amendment after final rejection filed November 4, 1996 (paper no. 10) has been approved for entry by the examiner but has not been clerically entered.

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rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. 4,208,527 to Horlbeck et al. (Hornbeck) (filed Jun. 17, 1980) and by U.S. 4,131,601 to Hashimoto et al. (Hashimoto).

We remand the application to the examiner because the examiner has not set forth a sufficient factual basis for the appeal to be decided.

In order for a claimed invention to be anticipated under 35 U.S.C. § 102(b), all of the elements of the claim must be found in one reference. *See Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Regarding the content of an examiner's answer, the Manual of Patent Examining Procedure (MPEP) states the following:

(c) For each rejection under 35 U.S.C. 102, the examiner's answer, or single prior action, shall explain why the rejected claims are anticipated or not patentable under 35 U.S.C. 102, pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection.

MPEP § 1208, p. 1200-19 (8th ed., Aug. 2001).

The examiner does not point out where all of the limitations recited in any of the appellants' claims are found in the applied references, and does not even mention any claim other than claim 1.

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The only discussion of specific disclosures in Horlbeck by the examiner is the following (answer, page 4):

Hirlbeck et al. disclose process for preparing high molecular weight PET in two stages as claimed, wherein terephthalic acid is reacted with ethylene glycol in the presence of 35-290 ppm of Mn and 6-95 ppm of cobalt to give low molecular weight precondensate which is then polycondensed in the presence of phosphorous compounds, germanium and titanium compounds to provide a product with improved color characteristics.

As for Hashimoto, the examiner merely states (answer, page 5):

"The prior art to Hashimoto et al. discloses a process and composition for preparing linear, highly polymerized polyesters by two stages as claimed."

The examiner correctly points out that the appellants' claim 1 does not require cobalt, i.e., "up to 80 ppm" in that claim includes zero. See *In re Mochel*, 470 F.2d 638, 640, 176 USPQ 194, 195 (CCPA 1972); *In re Egbert*, 298 F.2d 947, 948, 132 USPQ 456, 458 (CCPA 1962). The examiner, however, does not point out where either Horlbeck or Hashimoto discloses, in combination, 20-120 ppm of a transesterification metal catalyst, an amount of phosphoric acid, phosphorous acid, phosphonic acid and their esters which is 100% of the amount equivalent to the transesterification catalyst, and 1-10 ppm titanium, as required by claim 1, or discloses each of the limitations in any of the

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appellants' other claims. Both Horlbeck (tables 1 and 2) and Hashimoto (all examples) disclose examples in which no cobalt is used, but the examiner does not point out where each limitation of any of the appellants' claims appears in any of these examples or elsewhere in the disclosures.

We remand the application to the examiner so that the examiner can reopen prosecution and point out, as required by the MPEP for a rejection under 35 U.S.C. § 102(b), where each limitation of the appellants' claims is found in each of Horlbeck and Hashimoto. If the examiner finds that each limitation of any of the appellants' claims is not found in either reference, then the examiner should determine whether the process or product recited in those claims would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103 over the references and the admitted prior art. If so, the examiner, as required by MPEP § 1208, is to point out where each claim limitation which is found in the references appears in those references, and to explain how the subject matter of each of the appellants' claims would have been rendered obvious to one of ordinary skill in the art by the applied prior art. Whether the rejection is under 35 U.S.C. § 102(b) or § 103, the

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appellants should respond specifically to each point made by the examiner.²

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01(D). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

Chung K. Pak
CHUNG K. PAK)
Administrative Patent Judge)
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)
Terry J. Owens
TERRY J. OWENS)
Administrative Patent Judge)
)
Thomas A. Waltz
THOMAS A. WALTZ)
Administrative Patent Judge)

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² The examiner should have the chance to claim 1 in the amendment filed on November 4, 1996 (paper no. 10) entered into claim 1 in the file (amendment filed August 28, 1995, paper no. 3, page 2).

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ARTEVA NORTH AMERICA S.A.R.L. d/b/a KoSa
4501 CHARLOTTE PARK DRIVE
CHARLOTTE, NC 28217-1979